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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/596,629

06/19/2000

Connie L. Chapman

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7590

03/28/2003

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SB

# Office Action Summary

Application No.

09/596,629

Applicant(s)

CHAPMAN ET AL.

Examiner

Douglas B Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 52 recites the limitation "the intranet system" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,356,909 to Spencer in view of U.S. Patent Number 5,276,869 to Forrest et al..
6. Spencer teaches the invention substantially as claimed (As in exemplary claim 52) including a network for distributing a proposal (col. 3, lines 8-25), the network having a plurality of users enrolled therein (col. 3, lines 8-25), each of the plurality of users having associated personnel information stored within the network (col. 3, lines 26-43), with the network comprising: a software module for creating and submitting a proposal over the network, the

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proposal being submitted by a proposal originator (col. 8, lines 5-67 and col. 9, lines 1-45); a software module for creating a profile of the proposal based upon a technical area relating to the proposal in response to accessing associated personnel information of the originator (col. 12, lines 28-39, Proposals can be classified by type.); a software module for transmitting a first notification message via e-mail to a first group of users based upon the created profile, the first group of users being within a plurality of users, wherein the message has a hyperlink to the proposal (col. 14, lines 17-27); a software module for selecting an evaluator by a technical review coordinator (col. 13, lines 45-57, the user of the screen described is a technical review coordinator.); a software module for submitting evaluation comments by the at least one evaluator (col. 16, lines 52-67 and col. 17, lines 1-3); a software module for submitting a recommendation of the invention disclosure by a technical review coordinator based upon the evaluation comments (col. 16, lines 36-51); and a software module for transmitting the recommendation of the proposal via e-mail to the users (col. 15, lines 41-54); however, Spencer does not explicitly teach a proposal as being an invention disclosure, the use of an intranet, or multiple e-mails for the notification and the distribution of hyperlinks.

Forrest teaches an intranet for submitting a proposal in the form of an invention disclosure (col. 2, lines 17-51). Official notice is taken that it was well known in the art at the time of the invention to send multiple emails instead of one for notification and hyperlink distribution purposes.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Spencer regarding a network for distributing a proposal with the teachings of Forrest regarding an intranet for distributing a an invention

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disclosure because an automated system for evaluating invention disclosure proposals increases the efficiency of the evaluation process (Forrest, col. 1, lines 25-67 and col. 2, lines 1-14). It would have been further obvious to one of ordinary skill in the Computer Networking art at the time of the invention to send multiple email notifications because it may be desirable for different groups of recipients to receive notifications at different times, with different information.

7. As to claims 53 and 54, Spencer teaches an intranet wherein the notification message is responsive to submission of the proposal (col. 14, lines 17-27).

8. As to claim 55, Forrest teaches an intranet wherein the profile comprises a functional manager of the inventor, a patent attorney, and technical review person (col. 5, lines 51-67 and col. 6, lines 1-9).

9. As to claim 56, Forrest teaches a profile comprising information relating to the inventor including the inventor's employee number, department number, building number, phone number and e-mail address (col. 4, lines 55-67 and col. 5, lines 1-8).

10. As to claim 57 and 58, the Spencer-Forrest combination does not explicitly teach a group of users comprising a business area manager, a supervisor of the inventor, the inventor, a technical review coordinator, a contract administrator, and an intellectual property administrator. Official notice it taken that is well known in the art to consult such people in a business environment. It would have been obvious to one of ordinary skill in the Computer Networking art to combine the teachings of the Spencer-Forrest combination regarding a network for distributing a proposal with the a step of informing a business area manager, a supervisor of the inventor, the inventor, a technical review coordinator, a contract administrator, and an

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intellectual property administrator because all of these people might have valuable insight into the process.

11. As to claim 59, Spencer teaches a software module for creating a proposal further comprising instructions for including an attachment (col. 12, lines 40-48, the user can attach a disclosure.).

12. As to claim 60, Forrest teaches a software module for creating an invention disclosure comprising instructions for sending a notification message to a co-inventor (col. 4, lines 33-54). For reasons discussed above it would have been obvious to include a hyperlink in this message.

13. As to claims 1-11, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

14. As to claims 12-21, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

15. As to claims 22-30, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

16. As to claims 31-41, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

17. As to claims 42-51, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

18. As to claims 61-70, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

### ***Conclusion***

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair  
March 23, 2003

DBB

  
MARK R. POWELL  
SUPERVISORY PATENT EXAMINER  
GROUP 2400